

Claim 9, line 2, after "cows" insert --by washing or dipping said udders and teats in said solution--; after "concentration" cancel "sufficient" and insert --effective--;

Line 3, after "kill" cancel "substantial amounts of"; after "pathogens" cancel "but insufficient to cause substantial" and insert --without causing--.

R E M A R K S

Preliminarily, the Examiner is thanked for her careful review of the above-identified application, even to noting the incorrect spelling of tetrahydroisohumulone in claim 7. Applicant has corrected that error herein. The claims now under prosecution, claims 1 to 8, have been amended to remove any informalities contained therein and, it is respectfully submitted, as so amended distinguish the prior art cited by the Examiner. Moreover, claim 9 has been amended to more clearly show that restriction should not be required between claims 1 to 8, on the one hand, and claims 9 to 14, on the other.

First, however, applicant affirms the telephone conversation referenced by the Examiner in which applicant traversed the requirement for restriction but elected to prosecute the claims of the method invention, which are claims 1 to 8. The reason for the traverse is that the requirements of MPEP 806.05 (h) are not believed to have been met.

For example, in paragraph 3 of the Action the Examiner states as the basis for requiring restriction: "In the instant case the product can be used in a different process, such as the use of hops in making beer." The response to this assertion is: "Not the product as now claimed." Referring to claim 9, the only independent product claim, that claim begins: "An aqueous solution or suspension for sanitizing the pathogen-carrying udders and teats of dairy cows, comprising...." Thus, the product claims are all limited to the general method of using the

process. Additionally, that claim has now been amended to add to that initial recitation, " by washing or dipping said udders and teats in said solution." So, the product as now claimed cannot be used in a different process, such as making beer, without disregarding the important process limitations recited in the product claims.

Further, it is noted that both the method and product inventions are classified in class 424, subclass 725. Thus only a single search is required in a single subclass in order for the Examiner to evaluate both the method and product claims. Particularly in view of the substantial costs to small business entity applicants in obtaining and maintaining patents, the Examiner is requested to review the requirement for restriction.

Claims 1 to 8 were rejected under Section 112 because of applicant's use of the terms, "substantial amounts" and "substantial trauma". Claim 1, and therefore dependent claims 2 to 7, has been amended hereby to remove that offending language. As the word "substantial" no longer appears in claim 1, undersigned counsel believes that the basis for the Section 112 rejection has been avoided. Claim 7 has been amended to correct the noted misspelling.

Referring now to the rejections on the merits, claims 1 to 8 were rejected under Section 102 as being anticipated by Japanese Appln. No. 01172332 A. As now amended, it is submitted that claims 1 to 8 distinguish the Japanese Application, which does not disclose the essential step of applicant's method: washing or dipping the udders and teats of cows with an aqueous solution an active ingredient of which is a hop compound . A translation of the Japanese application has been obtained, and a copy is enclosed herewith. It will there be seen that almost every method imaginable of administering the various herbs is disclosed...but not washing or dipping the teats and udders of cows in an extract solution.

Referring to the translation, the herbs are administered by "giving" them to cows.

[page 5, line 24] "The method of giving it is either oral or non-oral administration. As non-oral administration, intra muscular, intra stomach, skin, nasal and vein administration can be used."

[page 6, lines 14, 15] A prime method of administration is in feedstuffs. [page 8, first paragraph] A solution of extract was also provided to cows in lieu of water. [page 9, penultimate paragraph] Thus, it is submitted that the Japanese application does not in its disclosure meet the strict requirement of newly amended claim 1 that the extract be contained in a wash or dip.

Claims 1 to 8 were also rejected under Section 103 as unpatentable over U.S. Patent No. 4,170,638 in view of the Japanese application. While the '638 patent does disclose the use of a hops extract in preparing a deodorant to inhibit the growth of *S. aureus*, it does not disclose the application of solutions of hops extracts in washes or dips for cows, and the Japanese application, cited as a secondary reference, does not provide the missing piece to the puzzle because it does not disclose the use of washes or dips employing hops extracts. Indeed, the proposed combination of the disclosures of the '638 patent and the Japanese application would result in the application of a deodorant to cows, such deodorant being in the form of a soap, cream, paste, powder or solid soap, all of which are markedly impractical when it comes to dairy cows, and certainly not within the scope of applicant's claim 1.

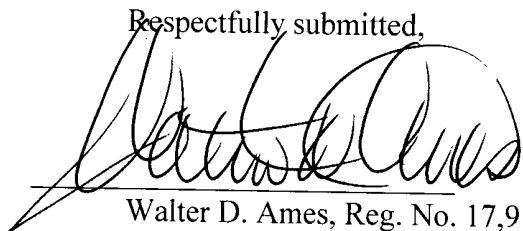
The final basis for rejection on the art is U.S. Patent No. 5,370,863 in view of the Japanese application. Here the primary reference teaches the use of hop acids in dentifrices. As this reference states at column 1, lines 53 to 56: "The novel oral care compositions of the present invention are toothpastes, tooth powders, mouthwashes, gums and the like which are formulated for administration to the oral cavity." While once again the general term, topical activity, might be used to describe the application of a hops compound in toothpaste to the oral cavity,

applicant's claim 1 now specifically recites a distinctive type of application which, while it might fall within the penumbra of a "topical application," is completely different from the type of application utilized for human beings in the "863 patent. It is believed self-evident that incorporation into a dentifrice for humans is not analogous to use in a wash or dip for the teats and udders of cows. Thus, it is respectfully submitted that there is nothing in the disclosure of the "863 patent that would suggest such the claimed use for hops compounds, regardless of the terminology that might possibly cover both methods of application.

As the use of hops compounds for washes and dips for cows is not found in any of the references cited, and as this is the essence of the present invention and is distinctly claimed in each of claims 1 to 8 under examination, it is believed that each of these claims is patentable. As each of the non-elected product claims is limited to hops solutions for sanitizing the udders and teats of cows by washing or dipping said udders and teats in said solutions, it is suggested that they are premised on the same method step not found in the prior art and, therefore, that claims 9 to 14 should be allowed with claims 1 to 8. Reconsideration in view of the newly amended claims is respectfully requested.

Respectfully submitted,

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Version With Markings To Show Changes Made

1. (amended). A method of sanitizing the udders and teats of of dairy cows, comprising washing or dipping [applying to] said udders and teats with an aqueous solution an active ingredient of which is a hop compound in a concentration effective [sufficient] to kill [substantial amounts of] pathogens on said udders and teats without causing [but insufficient to cause substantial]trauma to said cows [cow].

7 (amended). A method as claimed in claim 6, in which said hop compound is tetrahydroisohumulone [tetrahydroisohumulone].

9. (amended). An aqueous solution or suspension for sanitizing the pathogen-carrying udders and teats of dairy cows by washing or dipping said udders and teats in said solution, comprising a hop compound in a concentration effective [sufficient] to kill [substantial amounts of] said pathogens without causing [but insufficient to cause substantial] trauma to said cows.